

REMARKS

Claims 17-39 are pending in this application. Claims 17-39 stand rejected under 35 USC 112, second paragraph as allegedly indefinite. Applicant wishes to thank the Examiner for withdrawing the rejections under 35 USC 103, as well as for considering and entering the amendment to the specification including priority information.

Claim Rejection – 35 USC § 112 Second Paragraph

Claims 17-39 stand rejected under 35 USC 112, second paragraph for being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. More specifically, the Examiner asserts that it is unclear and indefinite to recite simultaneous, separate or sequential use of a combined preparation.

Applicant respectfully requests that the following after-final amendments be entered as they place the claims in condition for allowance and render the remaining rejection moot. More specifically, claim 17 has been amended to no longer recite simultaneous, separate or sequential administration of the combined preparation. Finally, claims 31, 35 and 39, all of which also pertain to simultaneous, separate or sequential administration of combined preparations, have been canceled.

Regarding claims 25-27, Applicant respectfully disagrees with the Examiner's assertion that upon pursuing the combined preparation aspect of the invention, claims 25-27 are duplicates that must be canceled. Applicant points out that claim 17 recites a product **containing** an alkylating anthracycline of formula Ia or Ib and an antimetabolite compound as a combined preparation. Claim 18 adds a further limitation of "further **containing** a pharmaceutically acceptable carrier or excipient." In contrast, claim 25 recites broader, more open "comprising" language. More specifically:

A pharmaceutical composition **comprising** a pharmaceutically acceptable carrier or excipient and, as an active ingredient, an alkylating anthracycline of formula Ia or Ib as defined in claim 17 and an antimetabolite compound that has a synergistic antineoplastic effect in mammals

The transition “comprising” is well established to be the most open, inclusive transition, one which unequivocally fails to exclude other elements. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495 (Fed. Cir. 1997) (“‘comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim”). In contrast, though some transitions can also be considered ‘open’ like comprising, there is some question whether any is universally considered equal to “comprising” (or relatives thereof, e.g., “comprised of”). Thus, while the specific elements recited in claims 17 and 18 are the same as those of claim 25, the comprising language is unequivocally open and enables the pharmaceutical composition of claim 25 to include other elements not recited in the claims. The “containing” of claims 17 and 18, while open, is generally not considered as inclusive as “comprising.” Thus, claims 25-27 are not strictly duplicates of claim 17 and its dependent claims, and, consequently, Applicant respectfully suggests that they need not be canceled.

Objections

The Examiner has objected to claim 24 because the term “5-fluorouracil” was misspelled. In response to the Examiner’s objection, Applicant amended the claim to properly spell “5-fluorouracil.” Further, Applicant has corrected similar misspellings in claims 30, 34 and 48. Thus, Applicant respectfully requests reconsideration and withdrawal of this objection.

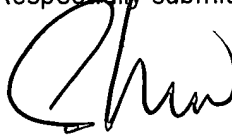
CONCLUSION

In light of the above, Applicant respectfully submits that the claims are in order for allowance and requests that the Examiner pass the application to issue. If there are any questions or comments regarding this Response or application, the Examiner is encouraged to contact the undersigned attorney as indicated below.

Dated: _____

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Respectfully submitted,



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